

RECEIVED
CENTRAL FAX CENTER

JUN 21 2004

520.39871X00/NT0318US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL

Applicant : Hiromasa TAKAHASHI *et al.*
Serial No. : 09/811,606RCE
Filed : 20 March 2001
For : MAGNETORESISTIVE SENSOR INCLUDING MAGNETIC
DOMAIN CONTROL LAYERS HAVING HIGH ELECTRIC
RESISTIVITY, MAGNETIC HEAD AND MAGNETIC DISK
APPARATUS
Group AU : 2652
Examiner : J. Watko
Conf. No. : 3900

SUPPLEMENTAL RESPONSE AND REQUEST FOR EXAMINER INTERVIEW**Mail Stop RCE**

Commissioner for Patents
POB 1450
Alexandria, Virginia 22313-1450

21 June 2004

Sir:

In response to the Advisory Action mailed 7 June 2004 for the Amendment After Final Rejection filed 21 May 2004 in response to the final Office Action dated 21 January 2004, and further to the Request for Continued Examination (RCE) filed concurrently herewith along with entry of the unentered 21 May Amendment After Final Rejection, the following additional remarks are respectfully submitted.

PENDING CLAIMS

Claims 1-12, 15-17, 19 and 21-22 were pending, with Claim 22 under consideration and subject to examination, at the time of the final Office Action. In the Amendment After Final Rejection, appropriate claims were amended, cancelled

TAKAHASHI *et al.*, 09/811,606RCE
Suppl. Resp./Req. Ex. Intv. dated 6/21/2004

520.39871X00/NT0318US1
Page 2

(without prejudice or disclaimer) and/or added in order to adjust a clarity and/or focus of Applicant's claimed invention. That is, such changes are unrelated to any prior art or scope adjustment and are simply refocused claims in which Applicant is presently interested. At entry of the Request for Continued Examination (RCE) filed concurrently herewith and the 21 May Amendment After Final Rejection, Claims 1-6, 15-17 and 21-26 are pending for further consideration and examination in the application.

INCOMPLETE EXAMINATION UNDER 37 CFR §1.104 - TRAVERSED

Applicant respectfully traverses the incomplete/improper examination of the present application under 37 CFR §1.104, and submits the following.

All descriptions of Applicant's disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed. As additional arguments, Applicant respectfully submits the following.

In the Amendment filed 5 January 2004, Applicant submitted substantive amendments to the claims, to clarify and correct same, although linking Claim 20 was inadvertently cancelled strictly through clerical error, without prejudice or disclaimer. Moreover, Applicant presented substantive argument over both the continued restriction of claims, and the rejection of claims over the applied prior art, and contended that all pending claims were in condition for allowance.

TAKAHASHI *et al.*, 09/811,606RCE
Suppl. Resp./Req. Ex. Intv. dated 6/21/2004

520.39871X00/NT0318US1
Page 3

In the final Office Action mailed 21 January 2004, no response whatsoever was made or even acknowledgment given to any of Applicant's arguments traversing the continued restriction or Applicant's arguments traversing the rejection of claims under the alleged teachings of the prior art. Furthermore, in the 21 January final Action, the Examiner additionally withdrew Claim 1 and the claims dependent thereon as well as new Claim 21 from consideration under the allegation that such claims were directed to a non-elected species of Figure 7 on the grounds of the word "granular."

In response to the improper withdrawal of additional claims and the first instance of complete non-response to any of Applicant's arguments submitted in the 5 January Amendment, Applicant submitted an Amendment After Final Rejection on 21 May 2004 in response to the 21 January 2004 final Action. In the 21 May Amendment, Applicant again clarified and corrected the claims, including reintroducing the inadvertently cancelled linking claim as new Claim 26, and again contended that all pending claims were in condition for allowance, as Applicant had previously stated in the 5 January Amendment. Further, in the 21 May Amendment After Final Rejection, in complete traverse of the Examiner's continued improper withdrawal of claims and rejection of claims, Applicant submitted additional explicit and complete arguments traversing both the alleged grounds for withdrawal of the claims and the rejection of claims over the alleged teachings of the applied prior art.

In response to the 21 May Amendment After Final Rejection, an Advisory Action was mailed 7 June 2004. For a second time, no rebuttal or even acknowledgment any of Applicant's arguments or traverses is given. The Advisory Action "Continuation Sheet" substantially merely reiterates Item 2(a) of the Advisory

TAKAHASHI *et al.*, 09/811,606RCE
Suppl. Resp./Req. Ex. Intv. dated 6/21/2004

520.39871X00/NT0318US1
Page 4

Action Form PTO-303, *i.e.*, "the addition of new claims" raises new issues that would require further consideration and/or search.

Applicant respectfully traverses the continued improper non-response to any arguments made in either the 5 January or 21 May 2004 Amendments.

In accordance with the USPTO Policy as stated in MPEP §707.07(f), "where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment. Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." More particularly, MPEP §707.07(f) states in relevant *verbatim*, "The importance of answering applicant's arguments is illustrated by *In re Hermann*, 261 F.2d 598, 120 USPQ 182 (CCPA 1958) where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable. See also *In re Soni*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995) (Office failed to rebut applicant's argument)." Since the Examiner has failed twice to respond in any way to any of Applicant's arguments and statements traversing the election requirement and the rejection of claims over the applied art, Applicant respectfully submits that the Examiner has acquiesced to Applicant's declaration of condition for allowance of all pending claims, and therefore, a Notice to that effect is respectfully requested.

TAKAHASHI *et al.*, 09/811,606RCE
Suppl. Resp./Req. Ex. Intv. dated 6/21/2004

520.39871X00/NT0318US1
Page 5

REQUEST FOR EXAMINER INTERVIEW BEFORE FURTHER ACTION

As stated in MPEP §713.01, "Examiners may grant one interview after final rejection. See MPEP §713.09." MPEP §713.09, in turn, states, "Normally, one interview after final rejection is permitted." Therefore, on 14 June 2004, the Examiner was contacted to determine if an informal telephone interview to discuss the application could be conducted in the interest of clarifying the invention and expediting the present application.

However, the Examiner stated that she did not grant Interviews after final rejection, including informal telephone discussions, without first receiving a "proposed amendment" to the claims either canceling rejected claims or further amending the claims over prior art. Since Applicant respectfully declined to unnecessarily amend the claims because such claims already define over the applied art and already are in condition for allowance, no Interview was conducted prior to the concurrent filing hereto of a Request for Continued Examination (RCE).

In view of the filing of a RCE and request for entry of the 21 May Amendment After Final Rejection, Applicant respectfully requests an Examiner Interview be conducted before a further Action is issued with respect to the present application, in the interest of trying to expedite prosecution of the present application.

The Examiner is respectfully requested to telephone the undersigned at the local D.C. area number of 703-312-6600 for the purpose of scheduling an Examiner Interview, and the Examiner is thanked in advance for such consideration. Contact also will be attempted by the undersigned to schedule an Examiner Interview. In the event that entry of the Amendment After Final Rejection in the present RCE is, in

TAKAHASHI *et al.*, 09/811,606RCE
Suppl. Resp./Req. Ex. Intv. dated 6/21/2004

520.39871X00/NT0318US1
Page 6

and of itself, sufficient to place the application in condition for allowance, no
Examiner Interview would be necessary.

RESERVATION OF RIGHTS

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer. That is, any above statements, or any present amendment or cancellation of claims (all made without prejudice or disclaimer), should not be taken as an indication or admission that any objection/rejection was valid, or as a disclaimer of any scope or subject matter. Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

CONCLUSION

A Request for Continued Examination (RCE) requesting entry of the 21 May Amendment After Final Rejection which was indicated as not entered in the Advisory Action and a Petition for an appropriate extension of the shortened statutory period as set by the Advisory Action (four (4) months from the mailing of the final Office Action) are filed concurrently herewith. To whatever other extent is actually required, Applicant petitions for an extension of time under 37 CFR §1.136. Also

TAKAHASHI *et al.*, 09/811,606RCE
Suppl. Resp./Req. Ex. Intv. dated 6/21/2004

520.39871X00/NT0318US1
Page 7

filed concurrently is a Form PTO-2038 authorizing payment of the requisite Petition and RCE filing fees. Since the required additional claim fee was submitted with the 21 May Amendment After Final, no further claim fees are required for entry of the RCE and the 21 May Amendment After Final. Please charge any actual shortage in fees due in connection with the filing of this paper to Deposit Account No. 01-2135 (referencing case No. 520.39871X00).

Respectfully submitted,



Paul J. Skwierawski
Registration No. 32,173
ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 North Seventeenth Street, Suite 1800
Arlington, Virginia 22209-3801, USA
Telephone 703-312-6600
Facsimile 703-312-6666

Concurrent Submissions:
Request for Continued Examination (RCE)
Petition for Extension of Time
Form PTO-2038 (Fee Codes 1801/1251)